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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,098

01/21/2004

Yukio Yamaguchi

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EXAMINER

CHANG, LEONARD

ART UNIT

PAPER NUMBER

2812

MAIL DATE

DELIVERY MODE

08/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,098	<b>Applicant(s)</b> YAMAGUCHI, YUKIO	
	<b>Examiner</b> LEONARD CHANG	<b>Art Unit</b> 2812	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/244,074.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This Office Action is in response to Applicant's Remarks and Supplemental Declaration filed with the Office on January 21, 2009. It was previously noted In the Office Action mailed on October 14, 2008 that all claims from application 10/504,091 and the present application 10/761,098 are in condition for allowance. However, due to the declaration in this application being defective as noted below, and provisional non-statutory obvious type double patenting as noted below, the allowability of these claims is rescinded at this time, as they are now currently rejected. Therefore, claims 1-8 and 16-25 are currently pending in this re-issue application.

### ***Declaration***

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.
3. Specifically, a **new Declaration** need contain the additional following:
- a. The Declaration is not specific enough under MPEP § 1414(II)(C). MPEP § 1414(II)(C) states that ***“(a)ny error in the claims must be identified by reference to the specific patent claim(s) and the specific patent claim language wherein lies the error.”*** It further states that ***“(a) statement of “failure to include a patent claim directed to ...”*** and then presenting a newly added claim would not be considered sufficient “error” statement since the Applicant has not pointed out what the other patent claims lacked that the newly

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added claim has, or vice-versa. Such a statement would be no better than saying in the reissue oath or declaration that "this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified. The present Declaration merely states that the error was the patent claiming less than the patentee had a right to claim. This cited error is not specific enough under MPEP § 1414(II)(C). In other words -- what was wrong with the patented claims, specifically?

b. **The error identified must be located in the patent that is being reissued.** It is unclear why **US Patent 6,081,029** is being mentioned.

c. **The filing date for the foreign priority document is incorrect.** Unless supplied in an application data sheet (ADS) (See 37 CFR 1.76), ***the oath or declaration must identify the foreign application, if any, on which foreign priority is being claimed by specifying the application number, country, day, month, and year of its filing as required by 37 CFR 1.63(c).*** If the original patent contains a claim for foreign priority, such claim must be repeated in the reissue application in order to retain priority to the earlier effective filing date. MPEP 1417.

d. The oath must acknowledge **duty to disclose information that is material to "patentability"**. The oath or declaration must state that the person signing acknowledges the duty to disclose to the Office all information known to

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the person to be material to patentability as defined in 37 CFR 1.56 as required by 37 CFR 1.63(b)(3).

e. A **new consent is required**. The signature date on the consent is missing.

### ***Claim Rejections***

4. **Claims 1-8 and 16-25** are rejected as being based upon a **defective reissue Declaration** under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

**Note:** This rejection based on a defective declaration was in the previous Office Actions of record. However, the Declaration was not corrected in response to the rejection(s).

### ***Double Patenting***

5. **Claims 16, 17** are **provisionally rejected** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 26 and 27** of **copending Application No. 12/179884**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terminology of **“grooves”** is essentially the same as **“recess”**.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent. MPEP 1451.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD CHANG whose telephone number is (571)270-3691. The examiner can normally be reached on Mon-Thurs 9:00 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on (571) 272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leonard Chang/  
Examiner, Art Unit 2812

/Alexander G. Ghyka/  
Primary Examiner, Art Unit 2812